

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 22, 2005. At the time of the Office Action, Claims 1-21 were pending in this Application. Claims 1-7 and 13-19 were rejected and Claims 8-11, 20 and 21 were objected to as being dependent upon a rejected base claim. Claims 1-7 and 12-17 have been amended to further define various features of Applicants' invention. Claim 20 has been cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-7, 13, 14 and 16-19 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0164713 filed by Franz Dollinger et al. ("Dollinger"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiments.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1997). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the Dollinger reference cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because Dollinger does not show all the elements of the present Claims.

Independent Claims 1 and 14 each recite, among other features, "a reflector for an electromagnetic signal that can be modulated via the alternating value."

Applicants submit that Dollinger discloses a reflector element that utilizes an acoustic wave. In particular, "first resonator 4 together with the matching network 2 and the sensor 1 forms a resonator with regard to reflection of a surface acoustic wave." Page 3, paragraph 38. As such, Dollinger fails to disclose, teach or suggest a reflector element for an electromagnetic signal as recited in Claim 1.

Applicants request reconsideration, withdrawal of the §102 rejection and full allowance of Independent Claims 1 and 14 and Claims 2-12 and 14 which depend therefrom. As discussed below, Independent Claim 16 has been amended and placed in condition for allowance in accordance with Examiner's indication.

Rejections under 35 U.S.C. §103

Claims 1-7 and 13-19.

Claims 1-7 and 13-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,739,195 issued to James A. Evans et al. ("Evans et al.") in view of U.S. Patent 6,084,530 issued to Alex Pidwerbetsky et al. ("Pidwerbetsky et al."). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

According to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Similar to Dollinger, Evans discloses a transducer for sensing acoustical energy. See Abstract. As admitted by Examiner, Evans failed to disclose, teach or suggest a reflector that can be modulated by an alternating energy value. However, Examiner cites to Pidwerbetsky as teaching a reflector that can be modulated via alternating valves.

Applicants traverse. In order to combine references for an obviousness rejection, there must be some teaching, suggestion or incentive supporting the combination. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989). The fact that a prior art device could be modified so as to produce the claimed invention is not a basis for an

obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

In this case, Evans is directed to a system for assessing temperature changes over the surface of a tire. See Col. 3, lines 49-54. Signals generated by Evans are communicated via electrical conductors fed through an airtight seal. See Col. 6, lines 8-16. Pidwerbetsky relates generally to wireless communication systems using modulated backscatter technology. Col. 1, lines 35-37. Evans does not suggest the desirability of utilizing a wireless transmitter within a wheel. Pidwerbetsky does not suggest an applicability to use with a tire or wheel. Applicants respectfully submit that neither Evans nor Pidwerbetsky suggests the desirability of the proposed combination.

Accordingly, Applicants submit that there is not sufficient motivation to combine Evans and Pidwerbetsky. For at least this reason, Applicants request reconsideration, withdrawal of the §103(a) rejections and full allowance of Independent Claims 1, 13 and 15 and Claims 2-7 and 14 which depend therefrom.

Claims 15 and 16

Claims 15 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dollinger et al. Applicants respectfully traverse and submit the cited art does not render the claimed embodiment of the invention obvious.

As discussed below, Applicants submit that Claims 15 and 16 have been placed in condition for allowance according to Examiner's indications. Applicants request reconsideration and favorable action.

Allowable Subject Matter

Applicants appreciate Examiner's consideration and indication that Claims 8-11 and 20-21 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for the timely and favorable consideration of these claims.

To place the Application in condition for allowance in accordance with the Examiner's indications, Applicants amend Independent Claims 15, 16 and 17 respectively to include the elements of Claim 20 which Applicants now cancel. Accordingly, Independent Claims 15, 16 and 17 now reflect originally submitted elements that the Examiner has indicated to be allowable, and the remaining claims 18, 19 and 21 depend from allowable Independent claims. Therefore, Applicants respectfully request allowance of claims 15-19 and 21, as amended.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of Claims 1-21 as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2606.

Respectfully submitted,
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